



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,803	07/06/2001	Brian Yen	51861.00002	6824

30256 7590 01/10/2005

SQUIRE, SANDERS & DEMPSEY L.L.P
600 HANSEN WAY
PALO ALTO, CA 94304-1043

EXAMINER

WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/900,803

Applicant(s)

YEN, BRIAN

Examiner

Jalatee Worjloh

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 and 44-81 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-42 and 44-81 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/29/04 & 09/27/04.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This Office Action is responsive to the amendment filed on November 1, 2004, in which claims 2,3,16-18, 33, 34 and 59 were amended and claim 43 cancelled.

Response to Arguments

2. Applicant's arguments filed November 1, 2004 have been fully considered but they are not persuasive.

3. Applicant argues that there is no motivation to combine Tyson and Cooper et al. references because Napster "teaches away from incorporating a digital rights management system" and Tyson "teaches away from digital rights managements as Napster converted to a conventional file downloading service and other P2P systems that came afterwards have not solved this problem."

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Tyson and Cooper et al. teach a content distribution system and are analogous art. Although Tyson does not expressly disclose processing payment for data file and sending a first encryption dataset to decrypt the data file, Cooper et al. overcomes this deficiency. Therefore, it is proper to combine Tyson and Cooper et al., one of ordinary skill in

Art Unit: 3621

the art would have been motivated to do this because it prevents unauthorized individuals from accessing the digital content thus reducing piracy.

4. Claims 1-42 and 44-81 have been examined.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts. All that is necessary to make a sequence of operational steps a statutory process within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of “useful arts.” *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970). Also, a claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. *See AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452. **Please add hardware in the claims’ body.**

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 3621

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 8, 10-19, 23, 25-35, 39-49, 51, 53-60, 62, 64-71, 73, 75-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over “How the Old Napster Worked” by Jeff Tyson in view of US Publication No. 2001/0051996 to Cooper et al.

Napster discloses receiving, from a first peer, a request for a data file, the request including an ID (i.e. “user name”) of the first peer, identifying a second peer having the data file from an index of peers, sending, to the first peer, an address of the second peer (see page 2). Napster does not expressly disclose processing payment for the data file or sending a first encryption dataset to decrypt the data file. Cooper et al. disclose processing payment processing payment for the data file (see paragraph [0184]), and sending a first encryption dataset to decrypt the data file (see paragraph [0067]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Napster to include the steps of processing payment for the data file, sending a first encryption dataset to decrypt the data file. One of ordinary skill in the art would have been motivated to do this because it prevents unauthorized individuals from accessing the digital content thus reducing piracy.

Referring to claims 2 and 17, Napster discloses a second peer (see claims 1 and 16). Napster does not expressly disclose identifying a second peer geographically closest to the first peer. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the steps recited. The identifying a second peer having the data file from an index of peers step would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *in re*

Art Unit: 3621

Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to identify a second peer in any location because such data does not functionally relate to the steps in the method claimed.

Referring to claims 3 and 18, Napster discloses a second peer (see claims 1 and 16).

Napster does not expressly disclose identifying a second peer having a lowest number of pings in relation to the first peer. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the steps recited. The identifying a second peer having the data file from an index of peers step would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *in re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to identify a second peer of any type because such data does not functionally relate to the steps in the method claimed.

Referring to claims 4, 19, 35, 49, 60 and 71, Napster discloses the data file is a music file (see page 1).

Referring to claims 8, 23 and 39, Napster discloses a first and second peer (see claims 1 and 16 respectively above). Napster does not expressly disclose verifying a password from the first peer before processing payment and sending, to the first peer, the address of the second peer. Cooper et al. disclose verifying a password from the first peer before processing payment and sending, to the first peer, the address of the second peer (see paragraphs [0126] and [0130]). At the time the invention was made, it would have been obvious to a person of ordinary skill in

Art Unit: 3621

the art to modify the method disclose by Napster to include the step of verifying a password from the first peer before processing payment and sending, to the first peer, the address of the second peer. One of ordinary skill in the art would have been motivated it prevents unauthorized individuals from receiving the address of the second peer.

Referring to claims 10, 25 and 41, Although the “How the Old Napster Worked” does not explicitly indicate upon receipt, from the first peer, of a signal indicating inability to retrieve the data file, identifying another peer having the data file from an index of peers, sending, to the first peer an address of the another peer, this is a known processes of Napster. Napster, however, does not expressly disclose sending encryption dataset. Cooper et al. disclose sending an encryption dataset to decrypt the data file (see paragraph [0067]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Napster to include the step of sending a first encryption dataset to decrypt the data file. One of ordinary skill in the art would have been motivated to do this because it prevents unauthorized individuals from accessing the digital content thus reducing piracy.

Referring to claims 11, 26 and 42, Napster discloses a first peer (see claims 1 and 16). Napster does not expressly disclose updating the index of peers to indicate that the first per includes a copy of the data file. Cooper et al. disclose updating the index of peers to indicate that the first per includes a copy of the data file (see paragraphs [0109] and [0098]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Napster to include the step of updating the index of peers to indicate that the first per includes a copy of the data file. One of ordinary skill in the art would have been motivated to do this because it monitors the peer’s access/request of the data file.

Art Unit: 3621

Referring to claims 12, 27 and 44, Napster discloses a second peer (see claims 1 and 16 respectively above). Napster does not expressly disclose sending a second encryption dataset to the second peer. Cooper et al. disclose sending a second encryption dataset to the second peer (see paragraphs [005], [0067] and [0068]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Napster to include the step of sending a second encryption dataset to the second peer. One of ordinary skill in the art would have been motivated to do this because it provides additional data security.

Referring to claims 13, 28 and 45, Cooper et al. disclose the method wherein the second encryption dataset includes an encrypted public transaction key and an encrypted public key, the public key capable to encrypt data so that the encrypted data is decipherable only by the first peer (see paragraphs [0067]).

Referring to claims 14, 29, 47, 55,66 and 77, Cooper et al. disclose the first encryption dataset includes an encrypted private transaction key (see paragraphs [0067] & [0057]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Napster to include the first encryption dataset includes an encrypted private transaction key. One of ordinary skill in the art would have been motivated to do this because it provides data security and secures the data file.

Referring to claims 15, 30,56,67 and 78, Cooper et al. discloses the method wherein the encrypted private transaction key is decipherable only by he first peer (see paragraph [0082]).

Referring to claim 16, Napster discloses receive, from a first peer, a request for a data file, the request including an ID (i.e. "user name") of the first peer, identify a second peer having the data file form an index of peers, sending, to the first peer, an address of the second peer (see

Art Unit: 3621

page 2). Napster does not expressly disclose process payment for the data file or send a first encryption dataset to decrypt the data file. Cooper et al. disclose process payment processing payment for the data file (see paragraph [0184]), and send a first encryption dataset to decrypt the data file (see paragraph [0067]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Napster to include the steps of process payment for the data file, send a first encryption dataset to decrypt the data file. One of ordinary skill in the art would have been motivated to do this because it prevents unauthorized individuals from accessing the digital content thus reducing piracy.

Referring to claim 31, Napster discloses means for receiving, from a first peer, a request for a data file, the request including an ID (i.e. "user name") of the first peer, means for identifying a second peer having the data file form an index of peers, means for sending, to the first peer, an address of the second peer (see page 2). Napster does not expressly disclose means for processing payment for the data file or means for sending a first encryption dataset to decrypt the data file. Cooper et al. disclose means for processing payment processing payment for the data file (see paragraph [0184]), and means for sending a first encryption dataset to decrypt the data file (see paragraph [0067]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Napster to include means for processing payment for the data file, and means for sending a first encryption dataset to decrypt the data file. One of ordinary skill in the art would have been motivated to do this because it prevents unauthorized individuals from accessing the digital content thus reducing piracy.

Referring to claim 32, Napster discloses a data file index capable to store listings of data files, peers storing the data files, and encryption data needed to decrypt the data files; a

Art Unit: 3621

distribution engine, communicatively coupled to the index, capable to receive, from a first peer, a request for a data file, the request including an ID (i.e. "user name") of the first peer, identify a second peer having the data file from an index of peers, send, to the first peer, an address of the second peer (see entire document). Napster does not expressly disclose a distribution engine capable to process payment for the data file or send a first encryption dataset to decrypt the data file. Cooper et al. disclose a distribution engine capable to process payment for the data file (see paragraph [0184]), and send a first encryption dataset to decrypt the data file (see paragraph [0067]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Napster to include an engine capable of processing payment for the data file, sending a first encryption dataset to decrypt the data file. One of ordinary skill in the art would have been motivated to do this because it prevents unauthorized individuals from accessing the digital content thus reducing piracy.

Referring to claim 33, Napster discloses a distribution engine (see claim 32 above). Napster does not expressly disclose the engine identifies a second peer geographically closest to the first peer. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the step recited. The identifying a second peer having the data file from an index of peers step would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *in re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to identify a second peer in any location because such data does not functionally relate to the steps in the method claimed.

Art Unit: 3621

Referring to claim 34, Napster discloses a distribution engine (see claim 32 above). Napster does not expressly disclose the engine is further identifies a second peer having a lowest number of pings in relation to the first peer. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the steps recited. The identifying a second peer having the data file from an index of peers step would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *in re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to identify a second peer of any type because such data does not functionally relate to the steps in the method claimed.

Referring to claim 48, Napster discloses receiving, from the server, an address of a second peer having the data file; sending, to the second peer, a download request for the data file; receiving, from the second peer, the data file and outputting the data file (see the entire document). Napster does not expressly disclose sending, to a server, a purchase request for a data file, the purchase request including a peer identifier or receiving from the server a first encryption dataset for decrypting the data file. Cooper et al. disclose sending, to a server, a purchase request for a data file, the purchase request including a peer identifier (see paragraph [0184]), and receiving from the server a first encryption dataset for decrypting the data file (see paragraph [0067]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Napster to include the steps of sending, to a server, a purchase request for a data file, the purchase request including a peer identifier or receiving from

Art Unit: 3621

the server a first encryption dataset for decrypting the data file. One of ordinary skill in the art would have been motivated to do this because it prevents unauthorized individuals from accessing the digital content thus reducing piracy.

Referring to claims 51 and 62, Napster discloses a first and second peer (see claim 1). Napster does not expressly disclose sending a password to the server before receiving the address of a second peer having the data file and the first encryption dataset for decrypting the data file. Cooper et al. disclose sending a password to the server before receiving the address of a second peer having the data file and the first encryption dataset for decrypting the data file. (see paragraphs [0126] and [0130]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Napster to include the step of sending a password to the server before receiving the address of a second peer having the data file and the first encryption dataset for decrypting the data file. One of ordinary skill in the art would have been motivated it prevents unauthorized individuals from receiving the address of the second peer.

Referring to claims 53, 54, 64, 65, 75 and 76, Although the “How the Old Napster Worked” does not explicitly indicate a sending a signal indicating inability to download the data file and receiving an address of a third peer having the data file after sending the signal indicating inability to download the data file, this is a known processes of Napster.

Referring to claims 57 and 68, Cooper et al. disclose the decrypting the data file using the private transaction key and a private key only known to the first peer (see [0082]).

Referring to claims 58,69 and 80, Cooper et al. disclose storing an encrypted copy of the data file (see paragraph [0018], lines 12-15). As for notifying the server that the data file is stored, this is an inherent step.

Referring to claim 59, Napster discloses receive, from the server, an address of a second peer having the data file; send, to the second peer, a download request for the data file; receive, from the second peer, the data file and output the data file (see the entire document). Napster does not expressly disclose send, to a server, a purchase request for a data file, the purchase request including a peer identifier or receive from the server a first encryption dataset for decrypting the data file. Cooper et al. disclose send, to a server, a purchase request for a data file, the purchase request including a peer identifier (see paragraph [0184]), and receive from the server a first encryption dataset for decrypting the data file (see paragraph [0067]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Napster to include the steps of sending, to a server, a purchase request for a data file, the purchase request including a peer identifier or receiving from the server a first encryption dataset for decrypting the data file. One of ordinary skill in the art would have been motivated to do this because it prevents unauthorized individuals from accessing the digital content thus reducing piracy.

Referring to claim 70, Napster discloses a peer identification (i.e. "username") and an engine capable to receive, from the server, an address of a second peer having the data file; send, to the second peer, a download request for the data file; receive, from the second peer, the data file and output the data file (see the entire document). Napster does not expressly disclose send, to a server, a purchase request for a data file, the purchase request including a peer identifier,

Art Unit: 3621

receive from the server a first encryption dataset for decrypting the data file, decrypt the data file. Cooper et al. disclose send, to a server, a purchase request for a data file, the purchase request including a peer identifier (see paragraph [0184]), receive from the server a first encryption dataset for decrypting the data file (see paragraph [0067]), and decrypt the data file with the first encryption dataset (see paragraph [0060]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Napster an engine capable to send, to a server, a purchase request for a data file, the purchase request including a peer identifier, receive from the server a first encryption dataset for decrypting the data file, and decrypt the data file. One of ordinary skill in the art would have been motivated to do this because it prevents unauthorized individuals from accessing the digital content thus reducing piracy.

Referring to claim 73, Napster discloses an engine (see entire document). Napster does not expressly disclose send a password to the server before receiving the address of a second peer having the data file and the first encryption dataset for decrypting the data file. Cooper et al. disclose send a password to the server before receiving the address of a second peer having the data file and the first encryption dataset for decrypting the data file. (see paragraphs [0126] and [0130]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Napster to include the step of send a password to the server before receiving the address of a second peer having the data file and the first encryption dataset for decrypting the data file. One of ordinary skill in the art would have been motivated it prevents unauthorized individuals from receiving the address of the second peer.

Referring to claim 81, Napster discloses means for sending, to the second peer, a download request for the data file; means for receiving, from the second peer, the data file and

Art Unit: 3621

means for outputting the data file (see the entire document). Napster does not expressly disclose means for sending, to a server, a purchase request for a data file, the purchase request including a peer identifier or receiving from the server a first encryption dataset for decrypting the data file. Cooper et al. disclose means for sending, to a server, a purchase request for a data file, the purchase request including a peer identifier (see paragraph [0184]), and means for receiving from the server a first encryption dataset for decrypting the data file (see paragraph [0067]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Napster to include means for sending, to a server, a purchase request for a data file, the purchase request including a peer identifier or receiving from the server a first encryption dataset for decrypting the data file. One of ordinary skill in the art would have been motivated to do this because it prevents unauthorized individuals from accessing the digital content thus reducing piracy.

1. Claims 5-7, 9, 20-22, 24, 36, 50, 52, 61, 63, 72, 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over “How the Old Napster Worked” by Jeff Tyson in view of US Publication No. 2001/0051996 and Cooper et al. as applied to claims 1, 16, 32, 48, 59, 70 above, and further in view of US Publication No. 2002/011912 to Hunter et al.

Napster discloses a sending to the first peer data (see page 2). Napster does not expressly disclose selecting an advertisement to send to the first peer or sending to the first peer, an address, of a peer having the advertisement. Hunter et al. disclose selecting an advertisement to send to the first peer and sending, to the first peer, an address (i.e. URL link located on the top right corner of fig. 10) of a peer having the advertisement (see paragraphs [0086] and [0107],

Art Unit: 3621

lines 11-13). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Napster to include the steps of selecting an advertisement to send to the first peer or sending to the first peer, an address, of a peer having the advertisement. One of ordinary skill in the art would have been motivated to do this because it is an affected method for merchants to attract consumers.

Referring to claims 6, 21 and 37, Napster discloses a first peer (see claims 1, 20 & 36 above). Napster does not expressly disclose selecting an advertisement. Hunter discloses the selecting an advertisement is based on demographic data associated with the first peer (see paragraph [0082]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Napster to include the step of selecting an advertisement is based on demographic data associated with the first peer. One of ordinary skill in the art would have been motivated to do this because provided an affected method for merchants to target consumers.

Referring to claims 7, 22 and 38, Napster discloses a peer (see claims 1, 20 & 36 above). Napster does not expressly disclose the processing payment processes a reduced payment for the data file upon sending, to the first peer, the address of a peer having the advertisement. Hunter discloses processing payment processes a reduced payment for the data file upon sending, to the first peer, the address of a peer having the advertisement (*Hunter's invention "provides the ability to update music pricing at any time..."; thereby, allowing consumers to receive pricing specials or incentives*), see paragraph [0019]. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Napster to include the step of processing payment processes a reduced payment for the data file upon

Art Unit: 3621

sending, to the first peer, the address of a peer having the advertisement. One of ordinary skill in the art would have been motivated to do this because encourages consumers to legally purchase digital content.

Referring to claims 9 and 24, Napster discloses a first peer (see claim 1 above). Napster does not expressly disclose the processing does not occur until receipt, from the first peer, of a confirmation signal confirming receipt of the data file. Hunter et al. disclose the processing does not occur until receipt, from the first peer, of a confirmation signal confirming receipt of the data file (see paragraph [0060], lines 1-10): At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Napster to include the processing does not occur until receipt, from the first peer, of a confirmation signal confirming receipt of the data file. One of ordinary skill in the art would have been motivated to do this because it verifies that the first peer desires the file.

Referring to claims 20 and 36, Napster discloses a sending to the first peer data (see page 2). Napster does not expressly disclose select an advertisement to send to the first peer or send to the first peer, an address, of a peer having the advertisement. Hunter et al. disclose select an advertisement to send to the first peer and send to the first peer, an address (i.e. the URL link located on the top right corner of fig. 10), of a peer having the advertisement t (see paragraphs [0086] and [0107], lines 11-13). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Napster to include the instructions to select an advertisement to send to the first peer or send to the first peer, an address, of a peer having the advertisement. One of ordinary skill in the art would have been motivated to do this because provided an affected method for merchants to target consumers.

Referring to claim 50, Napster discloses a server (see claim 48 above). Napster does not expressly disclose receiving, from the server, an address of a peer having an advertisement and downloading, from the peer having the advertisement, the advertisement and playing the advertisement. Hunter et al. disclose receiving, from the server, an address (i.e. URL link to the page, located to on the top right corner of fig. 10) of a peer having an advertisement and downloading, from the peer having the advertisement, the advertisement and playing the advertisement (see paragraph [0086], see fig. 10). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Napster to include the steps of receiving, from the server, an address of a peer having an advertisement and downloading, from the peer having the advertisement, the advertisement and playing the advertisement. One of ordinary skill in the art would have been motivated to do this because provided an affected method of targeting consumers.

Referring to claims 52 and 63, Napster discloses the data file (see claims 48 and 59). Napster does not expressly disclose sending, to the server, a confirmation signal confirming receipt of the data file. Hunter et al. disclose sending, to the server, a confirmation signal confirming receipt of the data file (see paragraph [0060], lines 1-10). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Napster to include the step of sending, to the server, a confirmation signal confirming receipt of the data file. One of ordinary skill in the art would have been motivated to do this because it verifies that the first peer desires the file.

Referring to claim 61, Napster discloses a server (see claim 48 above). Napster does not expressly disclose receive, from the server, an address of a peer having an advertisement and

Art Unit: 3621

download, from the peer having the advertisement, the advertisement and play the advertisement. Hunter et al. disclose receive, from the server, an address (i.e. URL link to the page, located to on the top right corner of fig. 10) of a peer having an advertisement and download, from the peer having the advertisement, the advertisement and play the advertisement (see paragraph [0086], see fig. 10). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Napster to include instructions to receive, from the server, an address of a peer having an advertisement and download, from the peer having the advertisement, the advertisement and playing the advertisement. One of ordinary skill in the art would have been motivated to do this because provided an affected method of targeting consumers.

Referring to claim 72, Napster discloses a server (see claim 48 above). Napster does not expressly disclose receive, from the server, an address of a peer having an advertisement and download, from the peer having the advertisement, the advertisement and play the advertisement. Hunter et al. disclose receive, from the server, an address (i.e. URL link to the page, located to on the top right corner of fig. 10) of a peer having an advertisement and download, from the peer having the advertisement, the advertisement and play the advertisement (see paragraph [0086], see fig. 10). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the engine disclose by Napster to receive, from the server, an address of a peer having an advertisement and download, from the peer having the advertisement, the advertisement and play the advertisement. One of ordinary skill in the art would have been motivated to do this because provided an affected method of targeting consumers.

Referring to claim 74, Napster discloses the data file (see claim 70 above). Napster does not expressly disclose send, to the server, a confirmation signal confirming receipt of the data file. Hunter et al. disclose send, to the server, a confirmation signal confirming receipt of the data file (see paragraph [0060], lines 1-10). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the engine disclose by Napster to send, to the server, a confirmation signal confirming receipt of the data file. One of ordinary skill in the art would have been motivated to do this because it verifies that the first peer desires the file.

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

Art Unit: 3621

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 for Regular/After Final Actions and 703-746-9443 for Non-Official/Draft.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450***

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, V.A., Seventh floor receptionist.


**JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**


**Jalate Worjloh
Patent Examiner
Art Unit 3621**

January 3, 2005